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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/346,470	07/01/99	HILL	53-99

023713 HM12/0508  
GREENLEE WINNER AND SULLIVAN P C  
5370 MANHATTAN CIRCLE  
SUITE 201  
BOULDER CO 80303

EXAMINER
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MURPHY, J

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 05/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/346,470

Applicant(s)

HILL ET AL.

Examiner

Joseph F Murphy

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 July 1999.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-39 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☒ Other: *Fax Cover Sheet*.

Art Unit: 1646

### DETAILED ACTION

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Program for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Program. If you have any questions or suggestions please contact Paula Hutzell, Ph.D., Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-29, 31-33, drawn to a nucleic acid encoding an amino acid with the sequence as set forth in SEQ ID NO: 2, a vector, a host cell, and a method of hybridization.

Group II, claim(s) 1-29, 31-33, drawn to a nucleic acid encoding an amino acid with the sequence as set forth in SEQ ID NO: 4, a vector, a host cell, and a method of hybridization.

Group III, claim(s) 1-29, 31-33, drawn to a nucleic acid encoding an amino acid with the sequence as set forth in SEQ ID NO: 6, a vector, a host cell, and a method of hybridization.

Group IIII, claim(s) 1-29, 31-33, drawn to a nucleic acid encoding an amino acid with the sequence as set forth in SEQ ID NO: 10, a vector, a host cell, and a method of hybridization.

Group V, claim(s) 1-29, 31-33, drawn to a nucleic acid encoding an amino acid with the sequence as set forth in SEQ ID NO: 12, a vector, a host cell, and a method of hybridization.

Group VI, claim(s) 1-29, 31-33, drawn to a nucleic acid encoding an amino acid with the sequence as set forth in SEQ ID NO: 14, a vector, a host cell, and a method of hybridization.

Art Unit: 1646

Group VII, claim 30, drawn to an isolated polypeptide with an amino acid sequence as set forth in SEQ ID NO: 2.

Group VIII, claim 30, drawn to an isolated polypeptide with an amino acid sequence as set forth in SEQ ID NO: 4.

Group IX, claim 30, drawn to an isolated polypeptide with an amino acid sequence as set forth in SEQ ID NO: 6.

Group X, claim 30, drawn to an isolated polypeptide with an amino acid sequence as set forth in SEQ ID NO: 10.

Group XI, claim 30, drawn to an isolated polypeptide with an amino acid sequence as set forth in SEQ ID NO: 12.

Group XII, claim 30, drawn to an isolated polypeptide with an amino acid sequence as set forth in SEQ ID NO: 14.

Group XIII, claims 34-37, 39 drawn to a method of identifying a compound.

Group XIV, claim 38, drawn to a synthetic compound with insecticidal activity.

The inventions listed as Groups I-XIV do not meet the requirements for Unity of Invention or the following reasons:

Groups I-XII and XIV are drawn to separate, distinct inventions and are distinguished from each other because the special technical features which define them by chemical and physical characteristics i.e. structure/function, as well as biological functions are different and these special technical features are not shared by each invention. Since these special technical features are not shared by each product and since the common features do not establish an advance over the prior art, the inventions of Groups I-XII and XIV do not form a single inventive concept within the meaning of Rule 13.2

Art Unit: 1646

Inventions XIV and XIII are independent and distinct, each from the other, because the structure of the compound is independent of the means of identifying it, especially as the functional assay of group XIII would reasonably be expected to identify numerous compounds having distinct structures and functions.

The invention of Groups I-XII and XIV is separate and distinct from the invention of Group XIII because the invention of Groups I-XII and XIV may be used in other methods than those of Group XIII, such as in the production of the protein of interest.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and separate classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1646

*Sequence Rules*

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the following reasons:

According to 37 CFR 1.821(d) (MPEP § 2422), where the description or claims of a patent application discuss a sequence listing that is set forth in the "Sequence Listing" in accordance with paragraph (c) of this section, reference must be made to the sequence by use of the assigned identifier, in the text of the description or claims, even if the sequence is also embedded in the text of the description or claims of the patent application. Sequences appear on page 6, line 3, of the specification but are not identified by SEQ ID NO as required.

Appropriate correction is required.

Art Unit: 1646

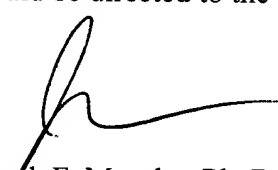
***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Murphy whose telephone number is 703-305-7245.


The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Joseph F. Murphy, Ph. D.  
Patent Examiner  
Art Unit 1646  
May 7, 2001

  
PREMA MERTZ  
PRIMARY EXAMINER



# RESTRICTION ELECTION FACSIMILE

TRANSMISSION

DATE:

FROM/ATTORNEY:

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COMMENTS:

IF YOU HAVE NOT RECEIVED ALL THE PAGES OF THIS TRANSMISSION, PLEASE CONTACT THE ATTORNEY AT THE TELEPHONE NUMBER LISTED ABOVE.

IN COMPLIANCE WITH 1096 OG 30, THE FILING DATE ACCORDED EACH OFFICIAL FAX TRANSMISSION WILL BE DETERMINED BY THE FAX MACHINE DATE STAMP FOUND ON THE LAST PAGE OF THE TRANSMISSION, UNLESS THAT DATE IS A SATURDAY, SUNDAY, OR FEDERAL HOLIDAY WITHIN THE DISTRICT OF COLUMBIA, IN WHICH CASE THE OFFICIAL DATE OF RECEIPT WILL BE THE NEXT BUSINESS DAY.

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